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IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF CALIFORNIA
SAN JOSE DIVISION

APPLE INC., <i>et al.</i>)	Case No.: 5:20-cv-06128-EJD
)	
Plaintiffs,)	Defendant's Notice of New Authority in
)	Support of His Motion to Dismiss
v.)	
)	Hon. Edward J. Davila
ANDREW HIRSHFELD,)	
Performing the Functions and Duties of the)	Date: Under Submission
Under Secretary of Commerce for Intellectual)	
Property and Director of the United States)	
Patent and Trademark Office,)	
)	
Defendant.)	

1 Defendant Andrew Hirshfeld, in his official capacity performing the functions and duties
 2 of the Under Secretary of Commerce for Intellectual Property and Director of the United States
 3 Patent and Trademark Office (“USPTO”), submits this notice of new authority in support of his
 4 motion to dismiss, ECF No. 64.

5 In *Mylan Laboratories Ltd. v. Janssen Pharmaceutica, N.V.*, 21-1071 (Fed. Cir. Mar. 12,
 6 2021), the Federal Circuit denied an appeal and mandamus petition concerning the denial of *inter*
 7 *partes* review (“IPR”) based on the application of the *Fintiv* factors. Exhibit A (*Mylan*
 8 Decision). Mylan sought mandamus relief based on (1) the USPTO “adopting the *Fintiv* standard
 9 through a precedential Board decision, rather than notice-and-comment rulemaking,” (2) “the *Fintiv*
 10 standard [allegedly] unlawfully shorten[ing] the limitations period for filing an IPR,” and (3) the
 11 alleged deprivation of due process from the denial of IPR institution based on parallel litigation. *Id.*
 12 at 10-11. The court rejected Mylan’s claims for relief, stating:

13 As the Supreme Court has explained, “the [Patent Office]’s decision to deny a petition
 14 is a matter committed to the Patent Office’s discretion. *See* [5 U.S.C.] § 701(a)(2); 35
 15 U.S.C. § 314(a) (no mandate to institute review).” *Cuozzo*, 136 S. Ct. at 2140. The
 16 Director is permitted, but never compelled, to institute an IPR. And no petitioner has a
 17 right to such institution. For example, the Director is free, as in this case, to determine
 18 that for reasons of administrative efficiency an IPR will not be instituted, as agencies
 19 generally are free, for similar reasons, to choose not to initiate enforcement
 20 proceedings. *Heckler v. Chaney*, 470 U.S. 821, 830–32 (1985). And the Supreme Court
 21 has determined that such a decision is committed to agency discretion by law. *Cuozzo*,
 22 136 S. Ct. at 2140. Given this determination and the statute’s bestowal of discretion on
 23 the Director combined with its prohibition on appeal of such decisions, we conclude
 24 that there is no reviewability of the Director’s exercise of his discretion to deny
 25 institution except for colorable constitutional claims.

26 *Id.* at 11-12. Defendant believes this new authority will assist the Court in its consideration of
 27 the pending motion to dismiss.

DATED: March 12, 2021

Respectfully submitted,

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/s/ Gary Feldon
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CERTIFICATE OF SERVICE

I hereby certify that on March 12, 2021, I electronically filed the foregoing document with the Clerk of the Court, using the CM/ECF system, which will send notification of such filing to the counsel of record in this matter who are registered on the CM/ECF system.

Executed on March 12, 2021, in Washington, D.C.

/s/ Gary Feldon
GARY D. FELDON